

Appl. No. 09/177,902  
Amdt. dated August 27, 2003  
Reply to Office action of March 27, 2003

### **Remarks/Arguments**

In his final rejection of March 27, 2003, the examiner has relied extensively on the admitted prior art system disclosed in the applicant's specification to form the basis of the Examiner's rejection for obviousness. The applicant had previously addressed any questions concerning this prior art system with the submission of an affidavit of Mr. Brian Dockendorff setting forth how the prior art system described in the specification had numerous drawbacks that were well known to those having skill in the art, and that the invention described and claimed in the instant patent application had overcome those drawbacks. In his final rejection, the examiner disputed the conclusion drawn by this affidavit, and instead argued that the affidavit did not "present any data (e.g. comparative test data) from which a conclusion of superior results can be drawn." The applicant has therefore submitted a second affidavit of Mr. Dockendorff concurrently herewith. In this affidavit, Mr. Dockendorff expands on his previous statements, providing the comparative data sought by the examiner.

As described by Mr. Dockendorff, the solid rod systems shown in the prior art and relied upon by the examiner in setting forth his obviousness rejection fail with remarkable frequency, typically every other week when used every day in standard analytical experiments. Mr. Dockendorff draws this from both PNNL record books and his own records, which reveal a minimum of four major failures requiring the system be re-built between October 18, 1996 and July 1, 1997. In addition, Mr. Dockendorff's recollection was that recalibration of the solid rod systems was required on almost a weekly basis.

In contrast, Mr. Dockendorff provides evidence that the rotating rod systems described and claimed in the above captioned patent application are essentially failure free. A rotating rod system was in place at Mr. Dockendorff's laboratory on July 2000 when he began working at PNNL has been used continuously by Mr. Dockendorff and his fellow scientists ever since.

Mr. Dockendorff's direct experience with these two systems over the course of the past 6 years has thus provided him with first hand knowledge allowing a direct comparison with the two systems, the salient points of which are recited in his affidavit. As documented by Mr. Dockendorff, the drawbacks and disadvantages inherent in the prior art solid rod type systems created significant incentives for alternative systems that would overcome these drawbacks and disadvantages, and those having ordinary skill in the art were very aware of these incentives. Despite the incentive for alternative systems that would overcome these drawbacks and disadvantages of these prior art solid rod systems, to Mr. Dockendorff's knowledge, none among those having ordinary skill in the art were able to conceive or reduce to practice any effective system for overcoming these disadvantages, until the rotating rod concept described in the above captioned patent application was conceived. As documented by Mr. Dockendorff's affidavit, the rotating rod concept described in the above captioned patent application actually fulfilled this long felt need among those having ordinary skill in the art for alternative systems by overcoming the drawbacks and disadvantages in the prior art solid rod systems, and quantified by Mr. Dockendorff's affidavit.

As set forth by the Federal Circuit, "Evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decision-maker remains in doubt after reviewing the art." *Stratoflex, Inc. v Aeroquip Corp.*, 713 F.2d 1530, 1538-40, 218 USPQ 871, 879 (Fed. Cir. 1983). The Affidavit of Mr. Dockendorff is concerned entirely such secondary considerations; specifically the fact that the present invention overcame a known drawback in the prior art, thereby filling a known and existing need. Again, as stated by the Federal Circuit, "Thus when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light. Such objective indicia as commercial success, or filling an existing need, illuminate the technological and commercial environment of the inventor, and aid in understanding the state of the art

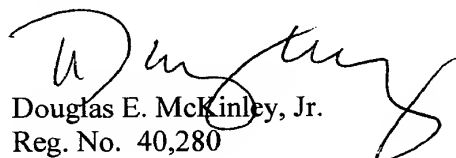
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at the time the invention was made.” Continental Can co. USA v. Monsanto Co., 948 F.2d 1264, 20 USPQ 2d 1746, 1752 (Fed. Cir. 1991).

When taken together with the binding Federal Circuit precedent, Mr. Dockendorff's affidavit thus compels a finding of non-obviousness. Mr. Dockendorff's affidavit establishes conclusively that the “objective indicia” of “filling an existing need” was met by the device described and claimed in the above captioned patent application. Mr. Dockendorff's affidavit establishes quantifiable comparisons between the prior art device and the present invention, and is now “the most probative and cogent evidence in the record” and establishes “that an invention appearing to have been obvious in light of the prior art was not.”

Applicant has made an earnest attempt to place the above referenced application in condition for allowance and action toward that end is respectfully requested. If the not allowed, the applicant respectfully requests that the affidavit off Mr. Brian Dockendorff nevertheless be entered into the record. Should the Examiner have any further observations or comments, she is invited to contact the undersigned for resolution.

Respectfully submitted,

  
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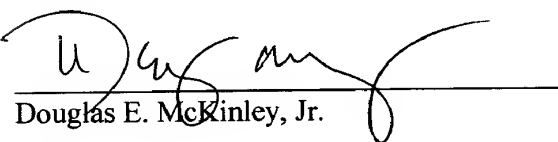
The undersigned hereby certifies that the forgoing Preliminary Amendment dated August 27, 2003 in reply to the office action of March 27, 2003, together with a fee sheet (form PTO/SB/17 1 page), and a request for continuing examination (form PTO/SB/30 1 page)

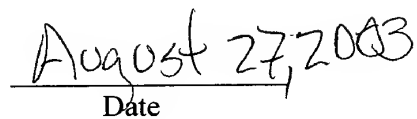
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and a return postcard are being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to

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on the date set forth below.

  
\_\_\_\_\_  
Douglas E. McKinley, Jr.

  
\_\_\_\_\_  
Date

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